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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/361,425	07/27/1999	JOHN KUNG	JBP461	5503

7590 09/26/2002
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EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 09/26/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/361,425

Applicant(s)

KUNG ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 11 September 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 17.

Claim(s) rejected: 7, 15 and 18-24.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The amendment to the claims does not resolve the current issues under 35 USC 112, second paragraph, and 35 USC 102(b) and 102(a), it also raise new issues regarding the number and the identity of oxygen-labile species contained in the composition, which have been changed, e.g, claims 7 and 23. In the amendment of September 11, 2002, claims 7 and 17-24 have been amended to add the term "wherein at least one of said oxygen-labile species is a retinoid" in claim 7, to replace "derivative" with classes of compounds such as "a retinoid", "an ascorbic acid" or "a tocopherol", and to amend the term "from about...to about...". Claim 23 has been amended to contain 0-10% of retinoid. Applicants' response has been fully considered, however, claims 7, 15 and 18-24 remain rejected under 35 USC 112, second paragraph, claim 7 is rejected under 35 USC 102(a), and claim 23 is rejected under 35 USC 102(b).

If applicants' amendment were entered, it would have the following response:

1. Claims 7, 18 and 21 are rejected under 35 USC 112, second paragraph as being indefinite because of the use of the term "a combination thereof" or "a combination of". The term "a combination thereof" or "a combination of" renders the claim indefinite, it is unclear how many oxygen-labile species and what amount of each species are contained in the composition. Note the claim cites Markush group, however, an open language "a combination thereof" is used.
2. Claims 15, 19 and 20 are indefinite because of the use of the term "from about one to about three", "derivatives", or "a mixture thereof". The term "from about one to about three", "derivatives", or "a mixture thereof" renders the claim indefinite, it is unclear how many oxygen-labile species are in the composition, e.g., are oxygen-labile species in the range of one to three, or more than three? It is also unclear what structure the derivative has and how different the derivative is from the parent compound, and how many oxygen-labile species and what amount of each species are contained in the composition. Note the claim cites Markush group, however, an open language "a mixture thereof" is used.
3. Claim 22, for example, is indefinite because of the use of the term "of about 0.01 to about 10%" for retinoid. The term "of about ...to about" renders the claim indefinite, it is unclear the amount of retinoid is below 10% as to "to 10%" or above 10% as to "about 10%". See also claims 23 and 24. Claim 23 is also indefinite because of the use of the term "from about 0.0 to about 10%" for retinoid, it is not clear the amount of retinoid is below 10% as to "to 10%" or above 10% as to "about 10%".
4. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Bland (U. S. Patent 5,637,324). Bland teaches a dietary composition comprising 0.05-0.25% by weight of calcium ascorbate, 0.1-0.4% of D-a-tocopherol, and 0.08-0.22 % of N-acetylcysteine (preferably 0.1%), (column 1, lines 59-60; column 2, lines 35-37, 41-44, 51-52; column 5, lines 3-23, 34-39), which meets the criteria of claim 23, where the composition can contain 0% of retinoid. In response, applicants indicate the claim has been amended to contain a retinoid compound, but the reference does not teach the composition contains a retinoid (page 8 of the response). The argument is not persuasive because claim 23 cites the amount of retinoid can be 0%, which indicates the composition contains ascorbate and N-acetylcysteine but not retinoid.
5. Claim 7 is rejected under 35 U.S.C. 102(a) as being anticipated by Fisher et al. (WO 98/55075). Fisher et al. teach a composition for ameliorating various effects of UV radiation comprising effective amounts of retinoid as MMP inhibitor and also an antioxidant such as ascorbic acid or N-acetylcysteine (page 5, lines 1-4; page 15, line 27-page 16, line 32; claims 1, 3, 4, 10 and 14 of WO 98/55075). In response, applicants indicate the reference only mentions retinoids, ascorbic acid and N-acetylcysteine as potential MMP inhibitors, it does not propose the formulation described by the amended claim (page 9 of the response). The argument is not persuasive because claims 10 and 14 of the reference recite the composition containing retinoid in addition to N-acetylcysteine.
6. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, the rejection of claims 7, 15 and 21 under USC 102 (b), and the rejection of claims 15, 18 and 21 under USC 102 (a).

Continuation of 5. does NOT place the application in condition for allowance because: The amendment to the claims does not resolve current issues under 35 USC 112, second paragraph, and under 35 USC 102(a) and 102(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*
September 23, 2002

Karen Cochrane Carlson
KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER